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U.S. Application Serial No. 88674888

Mark: MATCH STUDIO

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Reference/Docket No. 0115571/1

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, GARAN Services Corp. (hereinafter "Applicant"), has appealed the Trademark Examining Attorney's Final Refusal of registration of the applied-for mark "MATCH STUDIO", Application Serial No. 88674888. Registration of the applied-for mark was refused under Section 2(d), 15 U.S.C. §1052(d) of the Trademark Act for a likelihood of confusion with the marks in U.S. Registration Nos. 4808153 and 4808154 for "MATCH" with design and "MATCH" in standard characters.

FACTS

On October 31, 2019, Applicant applied to register the mark “MATCH STUDIO” for “Clothing, namely, tops and bottoms.” On February 10, 2020, the Trademark Examining Attorney issued a refusal under Section 2(d), 15 U.S.C. §1052(d) of the Trademark Act based upon a likelihood of confusion with the marks “MATCH” (with design) and “MATCH” (in standard characters) for “clothing and accessories for babies, adults, children, women and men, namely, caps; caps with visors; hats; beanies; coats for men, women and children, namely, coats made of cotton, heavy coats, over coats, rain coats; jackets for men, women and children, namely, outer jackets, rain proof jackets; denim pants; woven bottoms and tops; wearable garments and clothing, namely, shirts for adults, children, women and men, namely, button down shirts, collared shirts, dress shirts, crew necks, knit shirts, knit tops, long sleeve and short sleeve shirts, long and short sleeve t-shirts, tank tops, long sleeve pullovers; cardigans; crew neck sweaters; sweaters; v-neck sweaters; sweatshirts for babies, adults, children, women and men; hooded sweatshirts for babies, adults, children, women, men.” In addition, the Trademark Examining Attorney issued requirements for a disclaimer of the wording “STUDIOS” for being merely descriptive of a feature of applicant’s goods, and a requirement that the application be signed and properly verified.

On August 10, 2020, Applicant responded to the Office Action by submitting the required disclaimer, properly signing and therefore verifying the application, and arguing against the refusal under Section 2(d). Applicant argued primarily that the wording “MATCH” is highly suggestive and weak, and therefore entitled to a narrower scope of protection than an entirely arbitrary or coined word, and that the presence of one common element in the marks does not render the marks confusingly similar.

On August 13, 2020, the Trademark Examining Attorney issued a Final Refusal under Section 2(d) of the Trademark Act for likelihood of confusion with registered marks. Applicant requested reconsideration of the refusal on February 16, 2021, which was denied on March 8, 2021 because applicant's arguments were not found to be persuasive.

Applicant filed a Notice of Appeal on February 16, 2021 and submitted a brief on June 7, 2021.

ISSUES

The sole issue for consideration before the Board is whether Applicant's mark "MATCH STUDIO" for clothing is confusingly similar to the marks "MATCH" (with design) and "MATCH" (in standard characters under Section 2(d), 15 U.S.C. §1052(d) of the Trademark Act.

ARGUMENT

A. Overview of Likelihood of Confusion Analysis

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the "*du Pont* factors").

In re i.am.symbolic, llc, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

B. Applicant’s Mark is Likely to Cause Confusion with the Registered Marks When Used in Connection With the Specified Goods

The applied-for mark is “MATCH STUDIO” in standard character form for “Clothing, namely, tops and bottoms.”

Both Registration Nos. 4808153 and 4808154 for “MATCH” (with design) and “MATCH” (in standard character form) are for “clothing and accessories for babies, adults, children, women and men, namely, caps; caps with visors; hats; beanies; coats for men, women and children, namely, coats made of cotton, heavy coats, over coats, rain coats; jackets for men, women and children, namely, outer jackets, rain proof jackets; denim pants; woven bottoms and tops; wearable garments and clothing, namely, shirts for adults, children, women and men, namely, button down shirts, collared shirts, dress shirts, crew necks, knit shirts, knit tops, long sleeve and short sleeve shirts, long and short sleeve t-shirts, tank tops, long sleeve pullovers; cardigans; crew neck sweaters; sweaters; v-neck sweaters; sweatshirts for babies, adults, children, women and men; hooded sweatshirts for babies, adults, children, women, men.”

Applicant’s mark is substantially similar to Registrant’s marks in terms of appearance, pronunciation, connotation and commercial impression, and Applicant’s goods are highly related to Registrant’s goods, such that confusion is likely among consumers who are likely to mistakenly believe that Applicant’s goods and Registrant’s goods come from the same source or are affiliated goods from the same entity.

Applicant’s and Registrant’s Marks are Similar

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison*

Fondee En 1772, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v).

“Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (C.C.P.A. 1971)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

In the present case, the applied-for mark merely adds descriptive wording onto the registrant’s marks. The registered marks consist of the word “MATCH” whereas the applied-for mark adds the wording “STUDIO” onto these marks.

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterro Inc.*, 671 F.3d 1358, 1362, 101

USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party's goods is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). The previously attached evidence from www.lexico.com and www.designer.com showed that the wording "STUDIO" is commonly used in connection with similar goods to mean the place where clothing and fashion is designed. Applicant has disclaimed the wording "STUDIO" as it is merely descriptive of a feature of applicant's goods, thus rendering the wording "MATCH" the dominant element of the mark.

Additionally, the common wording "MATCH," appears first in applicant's mark. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because "VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because "consumers must first notice th[e] identical lead word"); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding "the identity of the marks' two initial words is particularly significant because consumers typically notice those words first"). Thus, the wording "MATCH" is further rendered the dominant element of the mark.

Although one of the registered marks contains a design element, this does not significantly differentiate the marks from one another for two reasons. First, when evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). Thus, although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterro Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Second, the applied-for mark is in standard characters. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterro Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the word portion could be presented in the same manner of display. *See, e.g., In re Viterro Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”). The dominant portion of applicant’s mark is identical to the entirety of registrant’s marks, thus they are confusingly similar.

Applicant first argues that the wording “MATCH” is highly suggestive and weak when used in connection with clothing. In support of this argument, applicant provided over fifty (50) applications and registrations that contain the word “MATCH” or words closely resembling “MATCH” for similar goods.

However, as the Trademark Examining Attorney argued previously, of all the third party registrations cited by Applicant, none of them consist solely of the word “MATCH” combined with descriptive wording. Each and every third party registration cited by Applicant consists of the word “MATCH” (or a word resembling “MATCH”) combined with additional, distinctive wording, and/or design elements. Applicant’s list of fifty-plus third party applications and registrations is padded with marks that bear no resemblance to the marks at issue, and some that don’t even feature the word “MATCH” or use it in a completely different nature as in the marks at issue.

For example, the following third party registrations cited by applicant utilize the wording “MATCH” as a verb, taking on a completely different meaning than the marks at issue:

Mark	Registration Number	Citation
MATCH MY HUSTLE	5888503	<i>See Response to Office Action dated August 10, 2020, TSDR p. 50)</i>
MATCH FOR SOLIDARITY	6060941	<i>See Response to Office Action dated August 10, 2020, TSDR p. 51)</i>
MATCH WITH MOMMY	5713805	<i>See Response to Office Action dated August 10, 2020, TSDR p. 52)</i>
MIX. MATCH. IMAGINE!	5938925	<i>See Response to Office Action dated August 10, 2020, TSDR p. 54)</i>

MATCH MUCH	5236631	See Response to Office Action dated August 10, 2020, TSDR p. 62)
MATCH-RIGHT	5160604	See Response to Office Action dated August 10, 2020, TSDR p. 63)
MATCH TUFF	5087905	See Response to Office Action dated August 10, 2020, TSDR p. 72)
MATCH. MEET. KLIQUE.	4895073	See Response to Office Action dated August 10, 2020, TSDR p. 73)
MIX & MATCH	5015123	See Response to Office Action dated August 10, 2020, TSDR p. 74)
SNAPPIES MATCH EVERYTHING...IN A SNAP!	5263230	See Response to Office Action dated August 10, 2020, TSDR p. 76)
MIX IT. MATCH IT. MAKE IT YOUR OWN!	4764185	See Response to Office Action dated August 10, 2020, TSDR p. 79)
SNAP & MATCH	4539292	See Response to Office Action dated August 10, 2020, TSDR p. 86)
MIX, MATCH, SAVE	3920406	See Response to Office Action dated August 10, 2020, TSDR p. 90)
MIX, MATCH AND SAVE	3920407	See Response to Office Action dated August 10, 2020, TSDR p. 91)
MIX, MATCH, SAVE MONEY	3920408	See Response to Office Action dated August 10, 2020, TSDR p. 92)
MIX, MATCH AND SAVE MONEY	3920409	See Response to Office Action dated August 10, 2020, TSDR p. 93)
MATCH ME	3234738	See Response to Office Action dated August 10, 2020, TSDR p. 94)

The following third party registrations utilize the word “MATCH” in a way that changes the very meaning of the word, such as “MATCH PLAY,” which is a type of scoring in various sports events:

MATCH PLAY	5926857	See Response to Office Action dated August 10, 2020, TSDR p. 68)
MATCH POINT	5030622	See Response to Office Action dated August 10, 2020, TSDR p. 69)
THE GREAT MATCH	2953324	See Response to Office Action dated August 10, 2020, TSDR p. 95)
MATCH PLAY OF PINEHURST	1037518	See Response to Office Action dated August 10, 2020, TSDR p. 99)
MATCHUP PROBLEM	5292364	See Response to Office Action dated August 10, 2020, TSDR p. 64)

The following third party registrations don't even contain the word "MATCH" – they contain wording that closely resembles the word "MATCH," such as "MATCHA," which is a type of tea:

MATCHES	4284458	See Response to Office Action dated August 10, 2020, TSDR p. 89)
MATCHLESS	4737051	See Response to Office Action dated August 10, 2020, TSDR p. 87)
MATCHESFASHION.COM	4508741	See Response to Office Action dated August 10, 2020, TSDR p. 84)
MATCHESFASHION	4566025	See Response to Office Action dated August 10, 2020, TSDR p. 85)
MATCHABAR	4812528	See Response to Office Action dated August 10, 2020, TSDR p. 77)
DRAGON WITH MATCHES	5473341	See Response to Office Action dated August 10, 2020, TSDR p. 59)
MATCHA LIFE	5335489	See Response to Office Action dated August 10, 2020, TSDR p. 60)
MATCHES	5755083	See Response to Office Action dated August 10, 2020, TSDR p. 53)
MATCHUMAN	5785863	See Response to Office Action dated August 10, 2020, TSDR p. 47)

The following third party registrations contain so many additional elements, the wording “MATCH” is rendered a minor element of the mark, and does not stand out in any way to create a commercial impression with consumers:

BOTTEGA THE PERFECT MATCH ESPRESSO BAR	5229889	See Response to Office Action dated August 10, 2020, TSDR p. 70)
TRANSLATION: S & P MATCH PERFECTLY, S & P AMAZING MATCHING	5778446	See Response to Office Action dated August 10, 2020, TSDR p. 58)
TRANSLATION: BRADORIA MATCH ALL TENDER	5463284	See Response to Office Action dated August 10, 2020, TSDR p. 57)
YOUR MATCH. REAL MONEY.	5748236	See Response to Office Action dated August 10, 2020, TSDR p. 56)
GRACELL YA SAI ER TRANSLATION: GRACELL GRACE MATCH YOU	6018621	See Response to Office Action dated August 10, 2020, TSDR p. 38)

The following marks cited by applicant are applications. Third-party applications are evidence only that the applications were filed; they are not evidence of use of the mark. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *see In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009); TBMP §1208.02; TMEP §710.03.

MATCH 5 TRIVIA	88867061	See Response to Office Action dated August 10, 2020, TSDR p. 33)
MATCH MY STATUS	88748091	See Response to Office Action dated August 10, 2020, TSDR p. 34)
MATCHALOHA	88734472	See Response to Office Action dated August 10, 2020, TSDR p. 35)
THE MATCH BEYOND	88691267	See Response to Office Action dated August 10, 2020, TSDR p. 36)
MATCH MY STATS	88641733	See Response to Office Action dated August 10, 2020, TSDR p. 37)
A MATCH MADE IN HELL	88588788	See Response to Office Action dated August 10, 2020, TSDR p. 39)
MATCH YOUR PUP	88536910	See Response to Office Action dated August 10, 2020, TSDR p. 40)
MATCH MADE IN HEAVEN	88509499	See Response to Office Action dated August 10, 2020, TSDR p. 41)
BORN IN ST. BARTS BIJOUX DE MER MIX AND MATCH	88338060	See Response to Office Action dated August 10, 2020, TSDR p. 44)
FOSFOROS GALILEO	88254301	See Response to Office Action dated August 10, 2020, TSDR p. 45)
MATCH GAME	88140264	See Response to Office Action dated August 10, 2020, TSDR p. 48)

As can clearly be seen, these marks cited by applicant do not convey the same overall commercial impression simply because of the inclusion of the word “MATCH” (or a word resembling “MATCH”). Some of these marks form commands, using “MATCH” as a verb rather than a noun, some are slogans, and others play on different meanings of the word “MATCH.”

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. See *Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of widespread third-party use of similar marks with similar goods and/or services "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection" in that particular industry or field. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1324, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005)).

Active third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. See, e.g., *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-40, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1036 (TTAB 2016); *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988) ; *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983) . Properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1976) ; *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) ; *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB

1987). Thus, if the wording in the third-party registrations are not used in the same manner as in the marks at issue, these third-party registrations are not relevant to show that this wording is diluted.

In the end, only a small number of third-party registrations cited by applicant utilize the word “MATCH” in the same way, and none of them contain the word “MATCH” combined with a merely descriptive term. Evidence comprising only a small number of third-party registrations for similar marks with similar goods and/or services, as in the present case, is generally entitled to little weight in determining the strength of a mark. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1328-29, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017); *AMF Inc. v. Am. Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). These few registrations are “not evidence of what happens in the market place or that customers are familiar with them.” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d at 1406, 177 USPQ at 269; *In re I-Coat Co.*, 126 USPQ2d 1730, 1735 (TTAB 2018). Thus, the relatively few similar third-party registrations submitted by applicant that actually use the word “MATCH” in the same nature are insufficient to establish that the wording “MATCH” is weak or diluted.

In the present case, the applied-for mark would appear as a sub-brand or additional line of registrant’s brand, since, as previously discussed, the wording “STUDIO” is merely descriptive of a feature of applicant’s goods. Indeed, similar to applicant’s arguments that the wording “MATCH” has application in the clothing industry, the wording “STUDIO” has an even stronger relation to that same industry. There are over 300 active registrations for clothing that contain the wording “STUDIO.” As a result, consumers would see “MATCH” and “MATCH STUDIO” as being related product lines, and thus, referring to the same source of goods.

Applicant has also provided extrinsic evidence of third-parties using the word “MATCH” in their trademarks. This evidence, however, suffers from the same problem as the third-party registrations cited by applicant. The wording “MATCH” is not used in the same manner as in the marks at issue, and in some cases, is not even shown being used with clothing goods. For example, applicant provided evidence from www.match5trivia.com, showing the mark “MATCH 5 TRIVIA” – but the mark is used with a trivia card game, not clothing. *See* Request for Reconsideration dated February 16, 2021, TSDR p. 7-8). Applicant also submitted evidence from www.matchyourpup.com, showing the wording “MATCHING PET AND OWNER CLOTHING.” *See* Request for Reconsideration dated February 16, 2021, TSDR p. 9-10). This wording, however, is being used to inform the customer about what kinds of goods the website contains. It is not being used in the same manner as the marks at issue. Applicant submitted evidence from California Seedbank, consisting of the mark “DRAGON WITH MATCHES,” with a mark featuring the type of matches that are used to start a fire or light a cigarette. *See* Request for Reconsideration dated February 16, 2021, TSDR p. 30). Not only that, but no clothing items are featured with this mark. The rest of the extrinsic evidence submitted by applicant follows the same pattern – the word “MATCH” may be featured in the third-party websites, but it is not being used in the same manner as the marks at issue.

To summarize, applicant’s argument that the wording “MATCH” is diluted and weak and, therefore, only entitled to a narrow scope of protection is based on numerous third-party marks that do not utilize the wording in the same nature and do not bear any resemblance to the marks at issue. The mere presence of a common word, embedded within other wording and elements in various marks to create distinctive and different commercial impressions, does not necessarily render that word diluted.

Because the wording “MATCH” is not used in the same manner in many of these third-party marks, applicant has not shown that the wording is “highly suggestive.” Even if, however, the wording is found to be “highly suggestive,” as applicant urges, this still would not necessarily avoid a finding of likelihood of confusion. The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection under Section 2(d) against the registration by a subsequent user of a similar mark for closely related goods and/or services. TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010). Suggestive wording is still distinctive wording, and entitled to protection. Because the only differentiating wording in the marks is the merely descriptive word “STUDIO,” consumers would be likely to be confused as to the source of applicant’s goods.

Applicant additionally argues that the Trademark Examining Attorney has improperly dissected the marks and has given no consideration to the significance of the additional elements that comprise the mark. This is not the case. The Trademark Examining Attorney evaluated the marks in their entireties, and applied relevant legal principles to determine that the wording “MATCH” was the dominant element in the applied-for mark. Marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (“[Regarding the issue of confusion,] there is nothing improper in stating that . . . more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985))).

For these reasons, the marks are confusingly similar.

Applicant's and Registrant's Goods are Related

Determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In this case, the application uses broad wording to describe “clothing, namely, tops and bottoms”, which presumably encompasses all goods of the type described, including registrant’s more narrowly-described goods that fall into these general categories. *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant’s and registrant’s goods are legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Additionally, the goods of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are “presumed to travel in the same channels of trade to the same class of

purchasers.” *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Thus, applicant’s and registrant’s goods are related.

Applicant did not present any arguments on Appeal that the goods of applicant and registrant differ, and thus, appears to concede that the goods are related. Where the goods and/or services of an applicant and registrant are identical or virtually identical, the degree of similarity between the marks required to support a finding that confusion is likely declines. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterro Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(b).

CONCLUSION

The foregoing demonstrates that Applicant’s mark “MATCH STUDIO” for clothing is likely to be confused with the marks in Registration Nos. 4808153 and 4808154 for “MATCH” with design and “MATCH” in standard characters, both for clothing. Therefore, the Trademark Examining Attorney respectfully requests that the refusal to register under Trademark Act Section 2(d), 15 U.S.C. §1052(d), be affirmed.

Respectfully submitted,

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